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Sen'ichi Onoda

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EXAMINER

TODD, GREGORY G

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/754,497	Applicant(s) ONODA ET AL.	
	Examiner GREGORY G. TODD	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a first office action in response to application filed, with the above serial number, on 12 January 2004 in which claims 1-43 are presented for examination. Claims 1-43 are pending in the application.

Claim Objections

2. Claims 19-20 are objected to because of the following informalities: The term "judgement" is a typo. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does

not make it statutory. (See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 and See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978)).

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

The claim scope is undetermined as a reasonable interpretation of the claims can refer to embodiments which are just software and/or a program per se.

Claims 40-43 are directed to "a program" which qualifies as software, per se, and is therefore non-statutory unless computer-implemented on a computer-readable medium.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office

personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

In order to expedite a comprehensive examination of the instant application, the claims rejected under 35 U.S.C.101 (non-statutory) above, are further rejected as set forth below in anticipation of applicant amending these claims to place them within the admissible statutory categories of invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 30-43 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the scope of the claim is undeterminable, one skilled in the art clearly would not know how to use the claimed invention commensurate in scope with these claims. See above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Negawa (hereinafter "Negawa", 7,055,030).

As per Claim 1, Negawa teaches a content usage management system for distributing, via a network, usage control data for controlling a content use in a client apparatus, comprising:

one or more distribution servers for distributing the usage control data to the client apparatus by a plurality of different distribution methods (at least col. 5:22-33; multicast server performing data distribution service); and

a distribution management server for determining a distribution method out of the plurality of distribution methods for distributing usage control data of each content according to attributes of said each content (at least col. 16:43-58; eg. management server),

wherein one of the distribution servers distributes the usage control data by the determined distribution method (at least col. 7:12-21; data via multicasting, session keys via unicast).

As per Claim 6. The content usage management system according to claim 1, wherein each of said one or more distribution servers includes at least one of the following units: a unicast distribution unit operable to distribute the usage control data by a unicast distribution method for distributing data in response to a request from the client apparatus; and a multicast distribution unit operable to distribute the usage control data by a multicast distribution method for distributing data all at once to a plurality of client apparatuses at a predetermined distribution time (at least col. 7:12-21; 14:45-15:5; unicast and multicast).

As per Claim 7. The content usage management system according to claim 6, wherein the distribution management server includes: a distribution method determination rule holding unit operable to hold a distribution method determination rule indicating a rule to determine the distribution method; and a distribution method determination unit operable to determine the distribution method according to the distribution method determination rule, with reference to the distribution method determination rule corresponding to the attributes of said each content (at least col. 7:12-21; 14:45-15:5).

As per Claim 8. The content usage management system according to claim 7, further comprising a content server for distributing contents to the client apparatus, wherein the distribution management server further includes: a method information generation unit

operable to generate information indicating the determined distribution method; and a method information sending unit operable to send the generated information indicating the distribution method to the content server by associating said information with the contents, wherein the content server distributes the contents including the information indicating the distribution method (at least col. 7:12-21; 14:45-15:5; col. 16:43-58).

As per Claim 9. The content usage management system according to claim 8, wherein the client apparatus includes: a content obtainment unit operable to obtain a content from the content server; a distribution method identification unit operable to extract the information indicating the distribution method from the obtained content and identify the distribution method for the usage control data corresponding to the content based on the extracted information; and a usage control data obtainment unit operable to obtain the usage control data from one of said distribution servers according to the identified distribution method (at least col. 7:12-21; 14:45-15:5; col. 16:43-58).

As per Claim 10. The content usage management system according to claim 9, wherein the usage control data obtainment unit (1) requests the unicast distribution unit to distribute the usage control data corresponding to the obtained content when the identified distribution method is the unicast distribution method, and (2) waits until the predetermined distribution time at which the usage control data corresponding to the content are distributed when the identified distribution method is the multicast distribution method (at least col. 7:12-21; 14:45-15:5; col. 16:43-58).

As per Claim 13. The content usage management system according to claim 6, wherein each of the distribution servers including the unicast distribution unit further includes an authentication unit to authenticate the client apparatus as an authorized user when the client apparatus is recognized as a previously registered client apparatus through communication with each client apparatus, wherein the unicast distribution unit distributes the usage control data only to the client apparatus recognized as an authorized user (at least col. 11:1-40; encryption for authorization).

As per Claim 14. The content usage management system according to claim 13, wherein the authentication unit authenticates the client apparatus by a PKI method (at least col. 11:1-40; PKI).

As per Claim 15. The content usage management system according to claim 13, wherein the authentication unit authenticates the client apparatus by a common key method (at least col. 11:1-40; key).

As per Claim 16. The content usage management system according to claim 6, wherein the distribution server including the multicast distribution unit includes a multicast content storage unit operable to store a multicast content that includes content and usage control data corresponding to said content, wherein the multicast distribution unit distributes the multicast content as the usage control data (at least col. 7:12-21; 14:45-15:5; col. 16:43-58; Fig. 2; eg. content database).

As per Claim 17. The content usage management system according to claim 16, further comprising a user management server that distributes a predetermined decryption key

only to a previously registered user, wherein the distribution management server includes a control data encryption unit operable to encrypt the usage control data determined to be distributed by the multicast distribution method, using a key corresponding to the predetermined decryption key, wherein the multicast content storage unit stores the multicast content including the encrypted usage control data (at least col. 11:1-40).

As per Claim 18. The content usage management system according to claim 16, further comprising a content server which distributes only the content whose usage control data is determined to be distributed by the unicast distribution method, wherein the unicast distribution unit distributes only the usage control data of said each content to be distributed by the content server (at least col. 7:12-21; 14:45-15:5; col. 16:43-58).

As per Claim 19. The content usage management system according to claim 18, wherein the client apparatus includes: a content request unit operable to request the content server to distribute the content and obtain the content; a distribution method judgement unit operable to judge a distribution method for the usage control data corresponding to the requested content, according to success or failure of the obtainment of the content from the content server; and a usage control data obtainment unit operable to obtain the usage control data from one of the distribution servers depending on a result of the judgment (at least col. 7:12-21; 14:45-15:5; col. 16:43-58).

As per Claim 20. The content usage management system according to claim 19, wherein the distribution method judgement unit judges (1) that the usage control data

are distributed by the unicast distribution method when the obtainment is successful, and (2) that the usage control data are distributed by the multicast distribution method when the obtainment is failed, and the usage control data obtainment unit (1) requests the distribution server to distribute the usage control data by the unicast distribution method to distribute the usage control data corresponding to the content successfully obtained, when it is judged that the usage control data are distributed by the unicast distribution method, and (2) waits until the predetermined distribution time at which the multicast content is distributed when it is judged that the usage control data are distributed by the multicast distribution method, the multicast content including the content failed to be obtained (at least col. 7:12-21; 14:45-15:5; col. 16:43-58).

As per Claim 21. The content usage management system according to claim 20, wherein the multicast content includes an encrypted usage control data, and the client apparatus further includes: a control data decryption key holding unit operable to previously hold a control data decryption key to decrypt the encrypted usage control data; a control data separation unit operable to separate the usage control data from the obtained multicast content when it is judged that the usage control data is distributed by the multicast distribution method; and a control data decryption unit operable to decrypt the separated usage control data using the control data decryption key held by the control data decryption unit (at least col. 11:1-40).

As per Claim 22. The content usage management system according to claim 1, wherein the usage control data include a decryption key to decrypt an encrypted content, and the client apparatus includes: a usage control data obtainment unit operable to obtain

the usage control data corresponding to said each content from any one of the distribution servers; a decryption unit operable to extract the decryption key from the obtained usage control data and decrypt the content corresponding to the usage control data using the extracted decryption key; and a reproduction unit operable to reproduce the decrypted content (at least col. 11:1-40).

As per Claim 23. The content usage management system according to claim 22, wherein the usage control data further include a use condition for using content, and the client apparatus further includes a reproduction control unit operable to extract the use condition from the obtained usage control data and control the reproduction unit to perform the reproduction within an extent to which the extracted use condition is satisfied (at least col. 11:1-40).

Claims 11-12, 24-25, and 30-43 do not substantially add or define any additional limitations over claims 1, 6-10, and 13-23 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negawa in view of Doty (hereinafter "Doty", 6,795,863).

As per Claim 2. Negawa fails to teach wherein the attributes of said each content include a compression format of said each content, and the distribution management server determines the distribution method for the usage control data according to the compression format of said each content. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Doty. Doty teaches a smart server determining a video server to multicast content based upon many factors including format, compression method, etc (at least col. 6:57-7:16; 8:48-9:4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate Doty's smart server with Negawa as Doty teaches the smart server determines the optimum video stream and thus video server for the client and all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill at the time of the invention.

As per Claim 3. Negawa fails to teach wherein the attributes of said each content include information to identify a content provider that provides said each content, and the distribution management server determines the distribution method for the usage control data according to the content provider of said each content. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Doty. Doty teaches a smart server determining a video server to multicast content based upon many factors

Art Unit: 2157

including format, compression method, etc (at least col. 6:57-7:16; 8:48-9:4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate Doty's smart server with Negawa as Doty teaches the smart server determines the optimum video stream and thus video server for the client and all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill at the time of the invention.

As per Claim 4. Negawa fails to teach wherein the attributes of said each content include a compression ratio of said each content, and the distribution management server determines the distribution method for the usage control data according to the compression ratio of said each content. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Doty. Doty teaches a smart server determining a video server to multicast content based upon many factors including format, compression method, etc (at least col. 6:57-7:16; 8:48-9:4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate Doty's smart server with Negawa as Doty teaches the smart server determines the optimum video stream and thus video server for the client and all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

combination would have yielded predictable results to one of ordinary skill at the time of the invention.

As per Claim 5. Negawa fails to teach wherein the attributes of said each content include a use condition of said each content, and the distribution management server determines the distribution method for the usage control data according to the use condition of said each content. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Doty. Doty teaches a smart server determining a video server to multicast content based upon many factors including format, compression method, etc (at least col. 6:57-7:16; 8:48-9:4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate Doty's smart server with Negawa as Doty teaches the smart server determines the optimum video stream and thus video server for the client and all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill at the time of the invention.

Claims 26-29 do not substantially add or define any additional limitations over claims 2-5 and therefore are rejected for similar reasons.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miura and Getsin et al, are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. G. T./
Examiner, Art Unit 2157

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157